

REMARKS/ARGUMENTS

The Office Action mailed September 3, 2003 has been reviewed and carefully considered. Before entry of the present amendment, Claims 10-33 were pending, with Claims 1 and 32 being in independent form. In the present amendment, two new drawings have been added (pursuant to the Examiner's requirement in the Office Action), and the specification has been amended in minor ways to refer to the new drawings and to explicitly mention features recited in the claims and elsewhere in the specification. Independent Claims 10 and 32 have been amended to clarify the nature of the present invention, and dependent Claims 11-31 and 32 have been amended to clarify the nature of the claimed invention, to comply with U.S. patent practice, and to clearly recite the combination of limitations intended. Dependent Claims 33-54 have been added in the present Amendment. After entry of the present amendment, Claims 10-54 will be pending, with Claims 1 and 32 being in independent form. Reconsideration and withdrawal of the objections and rejections in the September 3, 2003 Office Action are requested on the basis of the foregoing amendments and the following remarks.

In the Office Action dated September 3, 2003, the following issues were raised:

- I. The drawings were objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claim;
- II. Claims 13, 17, 21, 25, 27, 29, and 31 were rejected under 35 U.S.C. §112, first paragraph, as not enabled by the specification;
- III. Independent Claims 10 and 32, as well as Claims 12, 14, 16, 26, and 33 depending therefrom, were rejected under 35 U.S.C. §102(b) as anticipated by *Lamon et al.* (US 4,266,475; hereinafter *Lamon*);
- IV. Dependent Claims 11, 13, 15, 17, 19, 21, 27, 29, and 31 were rejected under 35 U.S.C. §103(a) as unpatentable over *Lamon* alone, or, in the alternative, *Lamon* in view of *Karr et al.* (US 4,501,197; hereinafter *Karr*); and
- V. Dependent Claims 18, 20, 22, 24, 25, and 28 were rejected under 35 U.S.C. §103(a) as anticipated by *Lamon* alone.

I. Objection to the drawings

The Examiner objected to the drawings stating that they did not show every feature of the invention specified in the claims. Specifically, the Examiner required that the features "...actuator means adapted to function between said bearing blocks..." in Claims 18-24 and "...cylinder portion of said hydraulic cylinders and hydraulic channels thereof are formed in said bearing blocks" in Claims 28-31 be shown in the drawings or canceled from the claims. In response, applicant has submitted two new drawings: FIG. 4 which shows the actuator means in the form of springs 9 adapted to function between bearing blocks 4, and FIG. 3 formed in bearing blocks 4. No new matter is contained in either drawing (as is partly shown by the minor additions required to refer to them in the specification). Support for the new drawings may be found in Claims 18-24 and 28-31, as well as at lines 20-23 on page 5 and lines 6-8 on page 7 of the originally filed specification.

Therefore, since the features pointed out by the Examiner are now shown in new FIGS. 3 and 4, applicant respectfully requests withdrawal of the objection.

II. Rejection of Claims 13, 17, 21, 25, 27, 29, and 31 under §112, first paragraph, as not enabled

The Examiner rejected dependent Claims 13, 17, 21, 25, 27, 29, and 31 under 35 U.S.C. §112, first paragraph, as containing subject matter "which was not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the invention" (Office Action, page 2). Applicant disagrees, at least because (1) the Examiner has not made a *prima facie* case for non-enablement, and (2) the description in the originally filed specification is sufficient to enable one skilled in the art to make the invention.

The standard for determining whether the specification meets the enablement requirement is whether any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent

need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

The Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Marzocchi*, 169 USPQ 367, 370 (CCPA 1971).

In fact, the MPEP (at §2164.04 BURDEN ON THE EXAMINER UNDER THE ENABLEMENT REQUIREMENT, bold emphasis added, underlined emphasis in original) states it very plainly:

... A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, **unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.**

...

... The language [in an enablement rejection] should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.

In the present case, the Examiner has asserted that "[w]ith regard to claim 13, the specification fails to provide details of how said actuator means comprising a hydraulic cylinder (clm. 13) and a spring (clm. 11) and how the two are interrelated" (Office Action, page 2). Regardless of whether the Examiner's statement is true or not, it is certainly irrelevant for a §112, first paragraph, enablement analysis, as is clearly shown in the above guidelines from the MPEP. For a proper rejection, there must be some objective reason why one skilled in the art would not be able to determine such details without undue experimentation. The Examiner has provided no reason why one skilled in the art would *not* be able to determine a configuration using both springs and hydraulic cylinders as actuator means once they have the present application in hand.

Because the Examiner has not provided a reason why one skilled in the art would *not* be able to determine a configuration using both springs and hydraulic cylinders without undue experimentation, the Examiner has not made a *prima facie* case for non-enablement. Therefore, the §112, first paragraph, non-enablement rejection of dependent Claims 13, 17, 21, 25, 27, 29, and 31 is unsupported, and its withdrawal is respectfully requested.

Disregarding the fact that there has been no proper non-enablement rejection, it should be noted that all of the pending claims in the present application are enabled by the present specification. One skilled in the art could make the invention claimed in any of the pending claims without undue experimentation. Furthermore, regarding the specific configuration at issue where both springs and hydraulic cylinders are used as actuator means, one skilled in the art can easily determine various embodiments.

For example, FIG. 1 has springs 9 as actuator means between the mounts 5, and FIG. 2 has hydraulic cylinders 19 as actuator means between mounts 5. Based on those two drawings, which are enabled, one of ordinary skill could imagine using a spring between the first (top) mount and the second mount (the one beneath the first), and then using a hydraulic cylinder between the second mount and the third mount. This is not to suggest that one would desire such a configuration, or that any of the present claims are in any way, shape, or form, limited to such a configuration. This is only intended as an example showing one of the multitude of possible configurations using both springs and hydraulic cylinders enabled by the present specification. Another configuration could use both a spring and a cylinder between the same two mounts, or a cylinder between two mounts

which are connected to bearing blocks which have a spring between them. All such configurations (whether using springs, hydraulic cylinders, or other actuator means) are enabled by the present application, as one skilled in the art could easily determine their "interrelationships" without undue experimentation.

Because one skilled in the art would be able to make *without undue experimentation*, the invention recited in dependent Claims 13, 17, 21, 25, 27, 29, and 31, dependent Claims 13, 17, 21, 25, 27, 29, and 31 are sufficiently enabled by the present specification. Thus, on this basis as well, withdrawal of their rejection is respectfully requested.

III. Rejection of Independent Claims 10 and 32, as well as Claims 12, 14, 16, 26, and 33 depending therefrom, under §102(b) as anticipated by *Lamon*

The Examiner rejected independent Claims 10 and 32 (as well as Claims 12, 14, 16, 26, and 33 depending therefrom) under 35 U.S.C. §102(b) as anticipated by *Lamon*. In response, applicant has slightly amended independent Claims 1 and 32 to clarify the nature of the claimed invention. These amendments contain no new matter: support for the amendments can be found on lines 23-32 of page 5 of the originally filed specification.

Amended independent Claims 1 and 32 recite a calendering system and method in which actuator means located between the mounts and/or bearing blocks of adjacent rolls relieves the linear loading the nip between the adjacent rolls caused by the weight of the rolls, bearing blocks, mounts, and any other actuator means located above the actuator means in the vertical stack of the calender.

By contrast, although *Lamon* has hydraulic cylinders positioned between the mounts of calender rolls, the purpose of *Lamon's* cylinders is to separate the rolls from each other in an emergency situation by an amount of gap d (see col. 5, lines 13-22, and FIG. 4). During calendering, the cylinders are operated so that the gap d between the flat portion 70 of the pin 62 and the upper surface of the rod eye 56 of piston rod 54 can be maintained against the weight of the piston rods (see col. 4, lines 45-50, and FIGS. 3 and 5). Thus, the cylinders in *Lamon* relieve only the loading imposed by the weight of the piston rod, not the linear loading on the nip imposed by

the weight of the overlying rolls, bearing blocks, mounts, and other piston rods, as does the invention claimed in independent Claims 10 and 32 of the present application.

In a vertical stack of calendering rolls, the linear loading on the nips caused by the weight of the rolls increases from the top to the bottom nip, i.e., the linear loading on the bottom nip is the highest, and the linear loading on the top nip is the least. In the calender system and method recited in Claims 10 and 32 of the present application, the actuator means between each set of adjacent rolls is individually adapted to the specific weight caused by the rolls above it. On the other hand, in *Lamon*, when the rolls are in their operating positions, hydraulic oil is supplied from a single pressurized reservoir 88, as seen in FIG. 5, through oil line 86 to the oil chambers 72 of the hydraulic pistons. Because the oil pressure is fed from a single source, the oil pressure is equal in the chambers of all the pistons of *Lamon*, and thus the lifting forces are also equal.

Thus, at least because *Lamon* neither teaches nor suggests an actuator means which is adapted to relieve the linear loading of a nip caused by the weight of the rolls, bearing blocks, and other actuator means located above that nip in the vertical stack, and independent Claims 10 and 32 do recite such a limitation, Claims 10 and 32 are patentable over *Lamon*, and thus are not anticipated by *Lamon*. Withdrawal of the rejection is respectfully requested. At least through their dependence on independent Claims 10 and 32, which are believed to be in condition for allowance, dependent Claims 12, 14, 16, 26, and 33 are also believed to be in condition for allowance, and withdrawal of their rejection is respectfully requested.

IV. Rejection of Dependent Claims 11, 13, 15, 176, 19, 21, 27, 29, and 31
under §103(a) as unpatentable over *Lamon* alone, or *Lamon* and *Karr*

The Examiner rejected dependent Claims 11, 13, 15, 176, 19, 21, 27, 29, and 31 under 35 U.S.C. §103(a) as unpatentable over *Lamon*, or, in the alternative, over *Lamon* in view of *Karr*. At least through their dependence on independent Claims 10 and 32, which are believed to be in condition for allowance, dependent Claims 11, 13, 15, 176, 19, 21, 27, 29, and 31 are also believed to be in condition for allowance, and withdrawal of their rejection is respectfully requested.

V. Rejection of Dependent Claims 18, 20, 22, 24, 25, and 28
under §103(a) as unpatentable over *Lamon* alone

The Examiner rejected dependent Claims 18, 20, 22, 24, 25, and 28 under 35 U.S.C. §103(a) as unpatentable over *Lamon*. At least through their dependence on independent Claims 10 and 32, which are believed to be in condition for allowance, dependent Claims 18, 20, 22, 24, 25, and 28 are also believed to be in condition for allowance, and withdrawal of their rejection is respectfully requested.

The addition of Claims 34-53

Dependent Claims 34-53 have been added in the present amendment, and none of them contain new matter:

support for newly added Claims 34-36 may be found in the entirety of the originally filed application, including, for example, the text on lines 23-32 on page 7;

support for newly added Claims 37-39 may be found in the entirety of the originally filed application, including, for example, the text on lines 7-14 on page 5;

support for newly added Claims 40-41 and 49 may be found in the entirety of the originally filed application, including, for example, the text on lines 23-31 on page 4;

support for newly added Claims 42-43 may be found in the entirety of the originally filed application, including, for example, the text from line 15 of page 5 to line 10 of page 6;

support for newly added Claim 44 may be found in the entirety of the originally filed application, including, for example, the text from line 32 of page 5 to line 4 of page 6;

support for newly added Claim 45 may be found in the entirety of the originally filed application, including, for example, the text from line 15 of page 5 to line 10 of page 6 and on lines 15-18 of page 6;

support for newly added Claim 46 may be found in the entirety of the originally filed application, including, for example, the text on lines 17-20 of page 6;

support for newly added Claim 47 may be found in the entirety of the originally filed application, including, for example, the text on lines 11-15 of page 6; and

support for newly added Claim 48 may be found in the entirety of the originally filed application, including, for example, the text on lines 8-10 of page 6;

support for newly added Claims 50-53 may be found in the entirety of the originally filed application, including, for example, the text on lines 22-28 of page 6; and

support for newly added Claim 54 may be found in the entirety of the originally filed application, including, for example, the text on lines 14-23 of page 7.

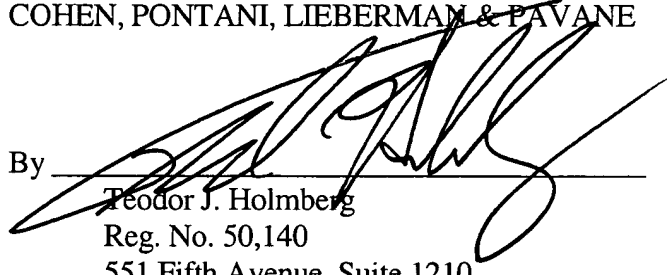
At least through their dependence on independent Claims 10 and 32, which are believed to be in condition for allowance, newly added dependent Claims 34-54 are also believed to be in condition for allowance, and withdrawal of their rejection is respectfully requested.

On the basis of the foregoing amendments and arguments, allowance of all pending claims is respectfully requested.

Respectfully submitted,

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